 means connected between the support and the motor for rotating the support upward when the motor is tilted from the down position to the up position.

REMARKS

This Amendment is in response to the Office Action mailed on April 8, 2003. In that Office Action, claims 29-40 are rejected under 35 U.S.C. §251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Claims 29-33 and 37-40 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Weiss, U.S. Patent No. 4,828,186. Claims 34-36 are rejected under 35 U.S.C. §103(a) as being unpatentable over Weiss in view of Stanley, U.S. Patent No. 1,172,176. Claims 1-28 are allowed.

The Examiner also stated that the application is defective because it fails to contain a statement that all errors, which are being corrected in the reissue application up to the time of filing of the Oath/Declaration, arose without any deceptive intent on the part of the Applicant. A Supplemental Declaration containing the exact phrase will be provided once claims 29-40 have been allowed. Additionally, a substantially similar statement was included in paragraph 7 of the Declaration signed by Mr. Poll on February 14, 2002 and submitted to the U.S. Patent and Trademark Office on February 20, 2002.

35 U.S.C. §251 REJECTIONS

Claims 29-40 are rejected under 35 U.S.C. §251 as being an improper recapture of broadened claimed subject surrendered in the application for the patent upon which the present reissue is based. Applicant respectfully disagrees as there was no subject matter surrendered to distinguish over prior art of record that applicant is now attempting to recapture.

An applicant is prevented from recapturing subject matter that was surrendered in an application to obtain the original patent. MPEP §1412.02. The Examiner cites *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 U.S.P.Q.2d 1641 (Fed. Cir. 1998) for the pronouncement of the

standard for determining recapture. "To determine whether an applicant surrendered particular subject matter, we look to the prosecution history arguments and changes to the claims made in an effort to **overcome a prior art rejection. (Emphasis added).** *Id. at 1480*. See also, *Mentor Corp. v. Coloplast, Inc.* 998 F.2d at 995-996, 27 U.S.P.Q.2d at 1524-25 (Fed. Cir. 1993); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 U.S.P.Q. 289, 294-95 (Fed. Cir. 1984). In, *In re Clement*, the Court of Appeals for the Federal Circuit has set forth a two-step test to determine if recapture has occurred. First, there must be determination of whether the reissue claims are broader than the patent claims. Second, if the claims are broader, there must be a determination as to whether the broader aspects of the reissue claims relate to surrendered subject matter. *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997).

The reissues claims do not relate to surrendered subject matter. The Examiner rejected claim 29, 34, 39 and 40 because the subject matter of claim 1 of the tie down bracket "placed between the trim adjustment rack of the motor and the transom of the boat" has been deleted. Additionally, the Examiner also rejected claims 29-40 because the subject matter of claim 18, a support "having a V-frame with a cradle at its apex, which is rotatable mounted with respect to the motor such that when the motor is an up position, the support can rotate about its mounting point to contact and support the motor in the cradle" has been deleted. In making this a rejection, the Examiner is requiring that claims 29, 34, 39 and 40 have all of the limitations of both claim 1 and claim 18. This is improper, claims 29, 34, 39 and 40 are not required to have all the limitations of both claim 1 and claim 18.

The phrase "placed between a trim adjustment rack of the motor and the transom of the boat" was added to claim 1 the same time that claim 18 was added to the application. Claim 18 does not contain the phrase "placed between a trim adjustment rack of the motor and the transom of the boat", and therefore, this limitation does not apply to claim 18. Additional claims are not required to have all the limitations of all the previous independent claims. Claims 29, 34, 39 and 40 are based on claim 18 and its limitations. Since claim 18 does not have the limitation of "placed

between a trim adjustment rack of the motor and the transom of the boat", claims 29, 34, 39 and 40 are not required to have that same limitation.

Claims 29, 34, 37, 39 and 40 are amended to each include a V-shaped support with an "upper" end and a "lower" end that is rotatably mounted, to reflect the language of claim 18 and to overcome the Examiner's rejection. The language of these claims are still a reflection of the language of claim 18 because the meaning of the claims still remain the same even though the specific word selection has changed. The addition of the word "upper" in the claims correlate with the word "apex" in claim 18, since the words are synonyms. The support for the addition is shown in Figs. 2, 3 and 4. Claims 30-33, 35-36 and 38 are dependant off of claims 29, 34 and 37. Therefore, they should also overcome the Examiner's rejection with the amendment of the respective independent claims.

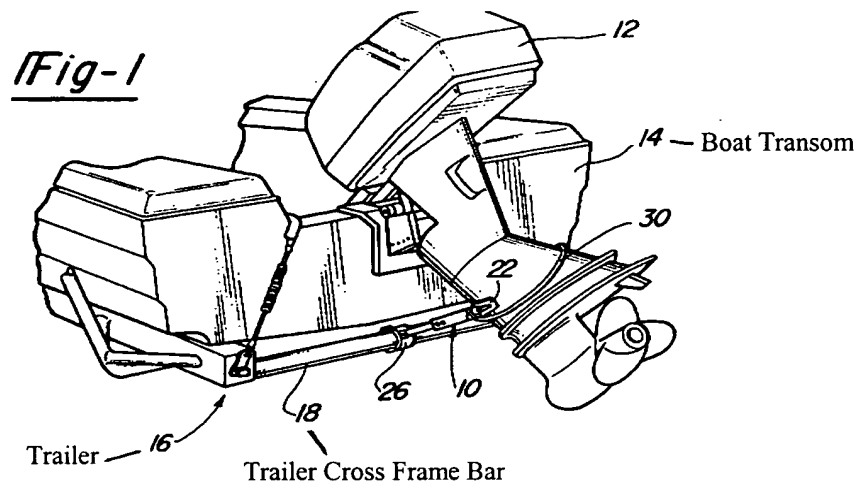
With this response, the rejection of claims 29-40 have been overcome. The application is now in condition for allowance and notice to that effect is respectfully requested.

35 U.S.C. §102(b) REJECTIONS

Claims 29-33 and 37-40 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Weiss. In order to be a §102(b) reference, the reference must teach each and every limitation of the claims. Weiss does not teach each and every limitation of the claimed invention.

The Weiss patent claims and teaches a device in which a rotatably mounted support is attached to a trailer beneath the boat. The Weiss device is a boat motor support to be utilized in towing a boat on a trailer and cannot be used in water. The device is comprised of a frame and motor mount brackets with adjustable telescoping arms used with cushion elements to absorb impact loads from the overhanging motor. Weiss' invention supports the boat motor with respect to the trailer. The invention of claims 29, 37, 39 and 40 pivotally connect to the boat on one end at a position above the bottom edge of the transom, while the other engages and supports the motor, allowing the motor support to be used in water.

For purposes of clarity, the following is a labeled copy of Fig. 1 of the Weiss patent.



The figure clearly shows that the tie down bracket and rotatably mounted support are not actually connected or attached to the transom, but are located on a trailer beneath the transom of the boat. The tie down bracket and rotatably mounted support of the Poll patent are located above the transom. The invention of the Weiss patent is located on a trailer below the boat. In fact, the Weiss invention is not meant for use on a boat at all, just in conjunction with a boat when it is on a trailer. This is unlike the Poll invention which is actually meant for use on the boat itself when the boat is on the water.

The Weiss device is not used at all with the motor is in its down position. It certainly is not in a position between the motor and the transom when the motor is in its down position. The invention of claims 29, 34, 37, 39 and 40 can work in conjunction with the motor in its down position. The Weiss device is not used with the motor is its down position.

Additionally, reference number 22 of the Weiss patent is a “cradle assembly”. The Weiss patent does not have a “v-shaped support having a cradle”. The v-shaped support and cradle in the Poll patent are two separate features; cradle 64 and V-frame 66. The Weiss patent only has

the cradle and does not have a separate v-shaped support, which is required by the Poll patent. Thus, Weiss does not teach each and every limitation of the claimed invention of claims 29, 37, 39 and 40. As such, claims 29, 37, 39 and 40 are not anticipated by Weiss.

Claims 30-33 and 38 were also rejected under 35 U.S.C. §102(b) as being clearly anticipate by Weiss. Claims 30-33 depend from claim 29, and claim 38 depend from claim 37. As previously set forth, claims 29, 37, 39 and 40 are not anticipated or otherwise taught by Weiss. Weiss does not teach the use of a support connected to a boat to be utilized in water. As such, Weiss does not suggest or teach every limitation on the claimed invention. Thus, claims 30-33, and 38 are not shown, suggested or taught by Weiss. Applicant has presented claims that are believed to be in condition for allowance and favorable action is respectfully requested.

35 U.S.C. §103(a) REJECTIONS

Claims 34-36 are rejected under 35 U.S.C. §103(a) as being unpatentable over Weiss in view of Stanley. The Examiner indicates that it would be obvious to a person of ordinary skill to combine the support found in the Weiss patent to pivot around a horizontal axis as taught by the Stanley patent. Applicant respectfully disagrees that the combination would have been obvious to one skilled in the art.

The combination of the two patents would not have been obvious to one of skill in the art. The invention of the Weiss patent is for use with a trailer, when the motor is not running and the boat is out of the water. The invention of the Stanley patent is for use with the motor running and in shallow water. Without the gift of hindsight, the incompatibility of the uses of the two inventions would have made the combination non-obvious.

When determining obviousness, "the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention". *Hodosh v. Block Drug Co., Inc.*, 786 F2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir.1986). Because of the completely different uses for the patents, one of skill in the art would not have automatically combined the two inventions. The Weiss patent was intended to be used with a trailer in order to transport the boat and

motor. The support connections for the Weiss patent are located on the trailer and not the boat itself. On the other hand, the Stanley patent was intended for use in shallow water with the support connections on the boat itself. It would not have been obvious for one of the art to go through the multi-step process of combining an invention for use in water with an invention for use out of water.

In order to achieve the combination required to come up with the invention of the Poll patent, one skilled in the art would be required to go through additional steps. After processing the use portion of the invention, one of the art would have then had to change the location of the entire device from the transom of the boat, as depicted in the Stanley patent, to a trailer underneath the boat, as depicted in the Weiss patent. Once the location transition was completed, the process of modifying the structure for use out of water would need to occur. With the gift of hindsight vision, the steps appear easy to make, but the multi-layered steps that it would have taken to get from one invention to the other is too many to be considered obvious. Applicant respectfully requests that rejection of claim 34 be withdrawn.

Since claims 35 and 36 are dependant upon claim 34, and claim 34 is believed to be allowable, then claims 35 and 36 are allowable. Applicant respectfully requests that rejection of claims 35 and 36 be withdrawn. Applicant respectfully requests that rejection of the claims be withdrawn. Reconsideration and allowance is respectfully requested.

In conclusion, Applicant believes this Amendment has been placed in a condition for allowance. Notice to that effect is respectfully requested. The Commissioner is authorized to charge any additional fees associated with this paper or credit any overpayment to Deposit Account No. 11-0982.

First Named Inventor: Steven J. Poll

Application No.: 09/803,453

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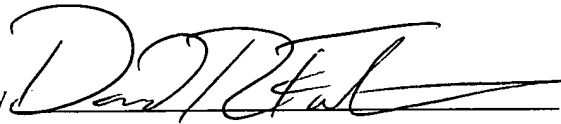
Respectfully submitted,

KINNEY & LANGE, P.A.

Date:

7/3/03

By



David R. Fairbairn, Reg. No. 26,047

THE KINNEY & LANGE BUILDING

312 South Third Street

Minneapolis, MN 55415-1002

Telephone: (612) 339-1863

Fax: (612) 339-6580

DRF:HLN:mep

**APPENDIX:
MARKED UP VERSION OF SPECIFICATION AND CLAIM AMENDMENTS**

29. An outboard motor support device for securing an outboard motor to a transom of a boat, the device comprising:

a tie down bracket;

a v-shape support with a cradle at an upper end and having a lower end rotatably mounted with respect to the motor at a position above a bottom edge of the transom such that when the motor is in an up position the support can rotate about its mounting point to contact and support the motor and when the motor is in a down position the support is positioned between the motor and the transom; and

a tie down element which passes behind the motor and is secured to the tie down bracket when the motor is in the up position to hold the motor in contact with the support.

34. An outboard motor support device for securing an outboard motor to a transom of a boat, the device comprising:

a rigid tie down member;

a v-shape support having a cradle at [a second] an upper end and having a [first] lower end rotatably mounted about a horizontal pivot axis which is generally parallel to the transom and located above a bottom edge of the transom such that when the motor is in an up position the support can rotate about the pivot axis to contact and support the motor in the cradle and when the motor is in a down position the support is positioned between the motor and the transom; and

a flexible tie down element connectable to opposite ends of the tie down member which passes behind the motor to hold the motor in contact with the cradle when the motor is in its up position.

**APPENDIX:
MARKED UP VERSION OF SPECIFICATION AND CLAIM AMENDMENTS**

37. An outboard motor support device for securing an outboard motor to a transom of a boat, the device comprising:

a tie down bracket having holes at opposite ends;

a v-shape support having a cradle at an [a first] upper end, wherein a [second] lower end of the support is mounted for pivotal movement about an axis located above a bottom edge of the transom such that when the motor is in an up position the support can rotate about its mounting point to a first position at which the cradle receives and supports the motor along a drive shaft housing of the motor and when the motor is in a down position the support is in second position between the motor and the transom; and

a tie down element having a pair of hooks secured to its ends, wherein each one of the hooks is secured in one of the holes in the tie down bracket and the tie down element passes behind the drive shaft housing of the motor to hold the drive shaft housing in contact with the cradle when the motor is in the up position.

39. An outboard motor support device for securing an outboard motor to a transom of a boat, the device comprising:

a rigid tie down member;

a v-shape support rotatably mounted at a [first] lower end and having a cradle at [a second] an upper end, the support being rotatable about a pivotal axis located above a bottom edge of the transom so that when the motor is in an up position the support can rotate about its [first] lower end so that the cradle receives and supports the motor along a drive shaft housing of the motor and when the

**APPENDIX:
MARKED UP VERSION OF SPECIFICATION AND CLAIM AMENDMENTS**

motor is in a down position the support is positioned between the motor and the transom; and

a flexible tie down element connectable to the rigid tie down member, which passes behind the motor for securing the drive shaft housing in place against the cradle when the motor is in an up position.

40.(Amended) An outboard motor support device for securing an outboard motor to a transom of a boat, the device comprising:

a rigid tie down member;

a v-shape support rotatably mounted at a [first] lower end and having a cradle at [a second] an upper end, the support being rotatable about a pivotal axis located above a bottom edge of the transom so that when the motor is in an up position the support can rotate about its [first] lower end so that the cradle receives and supports the motor along a drive shaft housing of the motor and when the motor is in a down position the support is positioned between the motor and the transom;

a flexible tie down element connectable to the rigid tie down member, which passes behind the motor for securing the drive shaft housing in place against the cradle when the motor is in an up position; and means connected between the support and the motor for rotating the support upward when the motor is tilted from the down position to the up position.